

REMARKS

Claims 1-11, 13-20, 23, and 37-48 are pending in the application. Claims 1-11, 13-20, 23, and 37-48 stand rejected. Applicants request further review and examination in view of the following remarks.

Related Co-pending Application with Allowable Subject Matter

Applicants advise the Examiner that notice of allowances in related U.S. Applications Nos. 10/646,645, 10/646,941, 10/646,646, and 10/646,580 have been received. Applicants advise the Examiner to check the file histories of the foregoing related cases.

Summary of Examiner Interview

On May 29, 2009 the undersigned conducted an interview with the Examiner. During the interview the terms “integrated” and “including” were discussed with respect to claim 1. Applicants disagree with the Examiner’s construction and no agreement was reached.

Claim Rejections – 35 USC § 101

Claims 37-42 stand rejected under 35 U.S.C. § 101 as allegedly directed towards non-statutory subject matter. The Office Action states that a claim must be tied to a machine or transform underlying subject matter into a different state in order to qualify as a patentable process. (Office Action at p. 2-3). Applicants submit claims 37-42 are sufficiently tied to a machine to satisfy 35 U.S.C. § 101.

The Federal Circuit’s recent *Bilski* decision did not elaborate on the ‘machine’ prong of the Machine or Transformation test, however it is clear from *Bilski* and prior cases that a process is sufficiently ‘tied’ to a machine when the machine imposes meaningful limits on the scope of the claim. *Id.* at 962. Or put another way, a claim is patentable when a machine is *needed* to carry out the claimed process. *See, e.g., State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *In re Comiskey*, 2009 U.S. App. LEXIS 400 (Fed. Cir. Jan. 13, 2009); *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2D (BNA) 1545 (Fed. Cir. 1994) and *AT&T Corp. v. Excel Communications, Inc.*,

172 F.3d 1352 (Fed. Cir. 1999). In these cases the courts held that processes that implicitly or explicitly require machines are patentable. In *State Street Bank* the claim was directed towards a processing system that takes data representing discrete dollar amounts through a series of mathematical calculations to determine a final share price. The *State Street* Court held that the claim satisfied section 101 because, “[g]iven the complexity of [the] calculations, a computer or equivalent device [was] a virtual necessity to perform the task.” *State Street Bank*, 149 F.3d at 1371 (emphasis added).

Furthermore, the Federal Circuit has found that claims that implicitly require machines are patentable. In *AT&T* the claim recited in part:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

The claim above does not positively recite the use of a machine and the *AT&T* Court stated that such limitations are irrelevant to a 101 inquiry. More specifically, the court stated that such structural inquiry was unnecessary and reflects a misunderstanding of the law. *See, e.g., AT&T Corp.*, at 1359. Instead of determining whether a machine was positively recited by the claim, the court stated that the ultimate issue always has been whether the claim as a whole is drawn to statutory subject matter. *Id.* at 1359.

Turning to the language of the claims, claim 37 recites in part:

executing an operating system including a kernel mode and a user mode, the kernel mode of the operating system including a database management program, the database management program integrated with a file system;

storing, by the file system, file data; ...and

exposing, by the database management program, the Items and the Item Folders to a shell of the operating system

Applicants submit that the claim satisfies at least the machine prong of the Machine or Transformation test because a machine is needed to performed the claimed process. Realistically, an operating system can not be ‘executed’ and file data can not be ‘stored,’ as understood by a person of ordinary skill in the art, without the use of a computer system such as the one described in FIG. 1. Accordingly, for at least this reason, Applicants respectfully request reconsideration of the 35 U.S.C. § 101 rejections of claims 37-42.

Compliance with U.S.C § 132 and 37 CFR § 1.104(a)(2)

Applicants submit that the Examiner has failed to provide sufficient information such that the Applicant can judge the propriety of continuing prosecution in violation of 35 U.S.C § 132 and 37 CFR § 1.104(a)(2). Applicants have reviewed the Office Action and submit that it is difficult to provide a meaningful response because of the lack of specificity in the Office Action as to how any of the documents describe “instructions the operating system *including* instructions for a database management program” and “instructions for the database management program *integrated* with instructions for a file system.” Instead of explaining in detail how the Bristor reference teaches or suggests the claimed subject matter within the meaning of 35 U.S.C. § 103 the Examiner merely parenthetically cites certain portions of Bristor. The Examiner has failed to explicitly construe the subject matter “an operating system that includes an operating system or a database management program that is integrated with a file system.” Without this information it is difficult for Applicants to provide a meaningful response or determine whether to continue prosecution. Such vague assertions do not comport with the standards of U.S.C § 132 and 37 CFR § 1.104(a)(2). Applicants submit that since the instant Office Action does not comport to the requirements of the law the Office Action must be withdrawn.

What follows is the most complete response possible given the vagaries of the Office action. Applicants respectfully request that any further Office Action comply with the specificity required by 35 U.S.C. § 132 and 37 CFR § 1.104(a)(2) so that the most meaningful response can be provided. In this regard, any further Office Action should contain the PTO’s view as to how the documents describe an operating system that includes

instructions for a database management program and “instructions for the database management program integrated with instructions for a file system.”

Applicants respectfully remind the Examiner that when construing the claim terms they must be given their ordinary and customary meaning, as determined by a person of skill in the art, after reviewing the *specification as a whole*. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). More specifically, the claims must be read *in view of the specification* of which they are a part. While the Patent Office can give the claims their broadest reasonable interpretation, the PTO is still required to proffer interpretations that are *consistent with the specification*. *See, c.g., In re Swanson*, 540 F.3d 1368 (Fed. Cir. 2008).

Claim Rejections – 35 USC § 103

Claims 1, 37, and 43 stand rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,018,342 to Bristor in view of U.S. Patent No. 7,158,962 to Nelson. Applicants traverse these rejections.

Claim 1

Bristor does not teach or suggest an operating system that includes instructions for a database management program

The Office Action states that col. 7, line 51 and col. 8, lines 1-18 teach or suggest “instructions for an operating system including a kernel mode and a user mode, the kernel mode of the operating system including instructions for a database management program.” Applicants disagree, however Applicants have amended in order to expedite prosecution. Col. 7, line 51 states “[b]y classifying user data as a history database according to symbols of the user data, the user data can be categorized automatically and in accordance with the content of the description of the user data.” Col. 8, lines 1-18 discuss a window including history buttons 108 that can be used to categorize user data. Applicants submit that the cited portions of Bristor are irrelevant to the claimed subject matter. Specifically, nothing in the cited portion of Bristor teaches or suggest that an operating system *includes* instructions for a

database management program. Col. 1, line 30 or Bristor makes a passing reference to the Unix operating system, however nothing in Bristor says that the database is a part of the operating system, instead the database could be merely installed on top of Unix. The Office Action has failed to establish how a software application that is installed on a computer that uses the resources of an operating system when executing is a software application that is included within the operating system. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 1.

Bristor does not teach or suggest instructions for a database management program integrated with instructions for a file system

The Office Action states that col. 8, lines 41-50 teach or suggest “instructions for the database management program integrated with instructions for a file system.” Applicants disagree.

Col. 8, lines 41-50 state in full:

In the example of FIG. 1B, the only command which includes a component whose initial letter is "L" is the command "ls mystuff*." Accordingly, the only item included in history menu 112L represents the command "ls mystuff*."

To retrieve and re-enter the command "ls mystuff*," the user selects the only item from history menu 112L as described more completely below. In response to the selection of the item by the user, the command "ls mystuff.*" is retrieved from a history database, which is described in greater detail below, and is processed as if the user had entered the command using conventional techniques.

Nothing in the cited portion of Bristor is remotely related to discussing a database management program that is integrated with instructions for a file system. Bristor is silent as to whether a database can be an integral part of a file system. In fact, Applicants have searched Bristor and submit that the term “file system” is completely absent from Bristor. Applicants submit that Bristor can not teach or suggest that claimed subject matter if it fails

to complexly mention part of the claim language. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 1.

Insomuch as dependent claims 2-11, 13-20, and 23 depend directly or indirectly from claim 1 Applicants respectfully request reconsideration of the rejections of these claims.

Independent claim 37 recites “executing an operating system, the operating system including a database management program, the database management program integrated with a file system.” Applicants submit that claim 37 defines over the cited art of record for at least similar reasons as claim 1. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 37.

Insomuch as dependent claims 38-42 depend directly or indirectly from claim 37 Applicants respectfully request reconsideration of the rejections of these claims.

Independent claim 43 recites “instructions for an operating system, the operating system including instructions for a database management program, the instructions for the database management program integrated with instructions for a file system.” Applicants submit that claim 43 defines over the cited art of record for at least similar reasons as claim 1. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 43.

Insomuch as dependent claims 44-48 depend directly or indirectly from claim 43 Applicants respectfully request reconsideration of the rejections of these claims.

CONCLUSION

Applicants request the Examiner reconsider the rejections and issue a Notice of Allowance of all the claims.

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